

# Notice of Allowability

Application No.

09/821,876

Examiner

Susan W Berman

Applicant(s)

WILHELM ET AL.

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment filed 07-20-2004.
2. ☒ The allowed claim(s) is/are 1-19.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

Susan W Berman  
Primary Examiner  
Art Unit: 1711

### REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

Applicant's amendment filed 07-20-2004 overcomes the objection to claims 15 and 16 and the rejection of claims 1-18 under 35 USC 112, second paragraph set forth in the Final Office Action.

The claims, as amended 03-24-2004, limit the alkoxyated multifunctional (meth)acrylate compound to alkoxyated (meth)acrylates not soluble in water and recite that the Brookfield viscosity of the fluid silico-acrylic composition after manufacture is below 1500 mPa.s. The Declaration of Dr. Can Vu Ngoc submitted 12-15-2003 establishes that the multifunctional alkoxyated (meth)acrylate monomers used in Examples 1-4 are water insoluble (meth)acrylates. SR-454, for example, contains three ethoxy groups. A comparison of example 1 of the invention with Comparative examples 2 and 3 and Example 3 of the invention with Comparative example 1 in the Declaration wherein the comparative examples use the water soluble highly ethoxylated (15 to 20 ethoxy groups) triacrylate preferred by Swofford supports the difference in stability and viscosity properties obtained for the instant invention and recited in the instant claims. Although Swofford also teaches using SARTOMER SR-454, shown in Sample D in Table X, in the disclosed compositions, it is agreed that Swofford teaches that a water soluble highly ethoxylated (meth)acrylate is preferred. Thus, the teaching of Swofford in combination with the comparative data in the Declaration obviates the prima facie obviousness of selecting a water insoluble alkoxyated (meth)acrylate from those taught by Swofford in the compositions disclosed by Swofford or in the analogous compositions taught by Jacquinot et al. This amendment in combination with the comparative data in the Declaration is considered sufficient to distinguish the instantly claimed invention from the prior art of record.

Art Unit: 1711

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Susan W Berman  
Primary Examiner  
Art Unit 1711

SB  
7/28/04